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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/514,054

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Terry T. Yu

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EXAMINER

JAGANNATHAN, MELANIE

ART UNIT

PAPER NUMBER

2666

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DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/514,054

Applicant(s)

YU ET AL.

Examiner

Melanie Jagannathan

Art Unit

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 39 is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-9, 12, 14-31, 33-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller et al. US 6,421,707.

Regarding claims 1, 8-9, 12, 14-16, 18-31, 33-38, the claimed machine receiving first message provided by first station and destined for second station is disclosed by mobile handset user sending to WDS (Figure 3, element 320) an email message for another user. See column 4, lines 21-35, column 5, and lines 15-34. The claimed machine converting the first message to an SMS message and sending the SMS message to second station is disclosed by user specifying a retrieval method of message being SMS and the WDS service complex (Figure 1, element 101) invoking appropriate converter contained in the converter bank (element 180). The claimed machine receiving a spoken response message from the second station and sending the spoken response message is disclosed by options for subscribers retrieving messages being an audio attachment to a message, .WAV attachment, played for user. See column 6, lines 20-24. The users in the wireless multimedia messaging communications method and apparatus

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disclosed by Miller et al. have options as to how to send and retrieve messages be it SMS messages or messages with .WAV attachments. See columns 5 and 6.

Regarding claims 2-5, the claimed first message defining a return ID associated with first station and machine storing correlation between the return ID and second station, machine receiving spoken response message from second station, the machine determining the return ID based on correlation and machine using return ID to direct spoken response message to first station is disclosed by user agent customization with user agent subsystem (Figure 1, element 120) where rules can be established for a recipient (second station or first station) that are sender specific (return ID of first station or second station). See column 3, lines 1-26, column 4, lines 41-60 and Figure 4(c).

Regarding claim 6, the claimed indication being mobile ID is disclosed by user agent customization including MIN. See Figure 4(c).

Regarding claim 7, the claimed machine providing in SMS message a callback number pointing to a port, machine receiving a call, spoken response message, to callback number from second station is disclosed by instant application stating it is well known in the art that SMS messages include callback numbers and Miller et al. including delivery subsystem (Figure 1, element 160) handling variety of outputs to user including voice through PSTN. See column 2, lines 58-64.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. in view of Smith et al. US 6,333,973.

Regarding claims 10-11, Miller et al. disclose all of the limitations of the claims except for second station comprising computer with wireless modem and first station comprising computer terminal and machine on packet switched network. Smith et al. discloses computer terminals and wireless telephones as subscribers to network. See Figure 1. At the time the invention was made it would have been obvious to a person of ordinary skill in the art to modify Miller et al. with subscribers of Smith et al. One of ordinary skill in the art would be motivated to do this to broaden range of subscribers.

5. Claims 13, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. in view of Daly et al. US 6,393,014.

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Regarding claims 13 and 32, Miller et al. disclose all of the limitations except for SMS message comprises generating an IS-41 SMDPP message. Daly et al. discloses short message service deliver point-to-point message where information is sent in the SMS bearer data of message. See column 5, lines 23-50. At the time the invention was made it would have been obvious to modify Miller et al. with SMDPP message. One of ordinary skill in the art would be motivated to do this for communication with IS-41 network.

Allowable Subject Matter

6. Claim 39 is allowed.

The following is a statement of reasons for the indication of allowable subject matter: Prior art of record does not disclose, in single or in combination, a wireless instant messaging system with IM server and IM client proxy, IM client proxy defining an IM client proxy address, IM server maintaining registration record indicating mobile station is available to receive messages but pointing to IM client proxy address, IM client proxy receiving message and sending message to mobile station, IM proxy receiving and sending spoken response message from mobile station.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Alanara et al. US 6,097,961 discloses mobile station originated SMS.

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Schwelb et al. US 5,950,123 disclose cellular telephone network support of audible information delivery.

Thakker et al. US 6,487,602 disclose system and method for sending SMS message in IP based cellular network.


Aravamudan et al. US 6,301,609 disclose user-definable instant messaging buddy groups.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Jagannathan whose telephone number is 703-305-8078. The examiner can normally be reached on Monday-Friday from 8:00 a.m.-4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on 703-308-5463. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Melanie Jagannathan
Patent Examiner
AU 2666


EBC
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